

The opinion in support of the decision being entered today was **not** written  
for publication and is **not** binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte VIVIAN GRAY and PAMELA G. DE MONY'E

---

Appeal No. 2001-2629  
Application No. 08/931,080

---

ON BRIEF

---

Before ABRAMS, McQUADE, and BAHR, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4, 11,  
12, 14, 16, 18 and 19, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

### BACKGROUND

The appellants' invention relates to a two-part absorbent garment comprising a reusable outer brief and a disposable inner absorbent liner. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Substitute Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Enloe <u>et al.</u> (Enloe)	4,846,825	Jul. 11, 1989
Stevens <u>et al.</u> (Stevens)	4,892,598	Jan. 9, 1990
Cooper	5,087,253	Feb. 11, 1992
Gagnon	5,217,447	Jun. 8, 1993
German Offenlegungsschrift (Reindl)	DE 26 48 932	May 3, 1978 <sup>1</sup>
French Patent Application (Pigneul)	2,606,257	May 13, 1988 <sup>1</sup>
PCT Application (Schmitz)	WO 95/02382	Jan. 26, 1995

As stated by the examiner on pages 5 and 6 of the Answer, the standing rejections are:<sup>2</sup>

---

<sup>1</sup>Our understanding of this foreign language reference was obtained through a PTO translation, a copy of which is enclosed.

<sup>2</sup>Rejections of claims 11, 16, 18 and 19 as being anticipated by Schmitz under 35 U.S.C. § 102(b), of claims 1, 2, 3, 4, 11, 12, 14, 16, 18, 19 as being unpatentable over Schmitz under 35 U.S.C. (continued...)

(1) Claims 12, 16 and 18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

(2) Claims 11, 16, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Schmitz in view of Cooper, Reindl and Pigneul.

(3) Claims 1 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Schmitz in view of Cooper, Reindl and Pigneul.

(4) Claims 2, 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Schmitz in view of Cooper, Reindl, Pigneul and Gagnon.

(5) Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Schmitz in view of Cooper, Reindl, Pigneul, Stevens and Enloe.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 29) and the final rejection (Paper No. 16) for the examiner's complete reasoning in support of the rejections, and to the Substitute Brief (Paper No. 27) and Substitute Reply Brief (Paper No. 33) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

---

<sup>2</sup>(...continued)  
§ 103(a), and of claims 1-4, 11 and 19 under 35 U.S.C. § 112, second paragraph, were withdrawn in the Answer (see the paragraph bridging pages 2 and 3)

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

*The Rejection Under Section 112, Second Paragraph*

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner has pointed out three errors in the claims which form the basis for the rejection under 35 U.S.C. § 112, second paragraph (see Answer, page 6 and Paper No. 16, page 4). The first of these is that the term “crotch” should be deleted from line 3 of claim 12 as reproduced in the appendix to the Substitute Brief, the second that “a” should be “the” in lines 7 and 8 of claim 16, and the third that there is no antecedent basis for “said absorbent disposable liner” in line 23 of claim 16. In view of the fact that the appellants have not disputed the examiner’s position with regard to the three matters raised above, and the discrepancies remain uncorrected, we are constrained to sustain the Section 112 rejection.

*The Rejections Under Section 103*

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The first of the Section 103 rejections is that claims 11, 16, 18 and 19 are unpatentable over Schmitz in view of Cooper, Reindl and Pigneul. As we understand this rejection, it is the examiner's position that all of the subject matter recited is disclosed or taught by Schmitz, except for the replaceable absorbent liner being separate from the reusable garment. With regard to this feature, it is the examiner's view that it would have been obvious to modify the one piece Schmitz garment into a two-piece arrangement having a separate liner, in view of the teachings of Cooper, Reindl and Pigneul (Paper No. 16, page 5).

It is important to recognize at the outset that the objective of the appellants' invention is to provide a two-piece garment comprising reusable briefs and an absorbent replaceable liner, whereby the liner can be removed from the briefs and exchanged for a new liner without the necessity to remove the briefs from the user's body. In furtherance of this, and as expressed in independent claim 11, the briefs comprise a waistband structure adapted to completely encircle the user's waist and a releasable panel extending from the back segment of the waistband structure toward the front segment of the waistband structure and forming a crotch segment. This releasable panel has an upper end portion that is placed in underlying relationship with the front segment of the waistband structure when worn and is releasably connected to the inside surface of the front segment of the waistband structure. The replaceable absorbable liner is positioned in overlying relationship with the releasable panel,

whereby when the garment is worn by the person, the upper end portion of the front segment of the releasable panel can be released from the front segment of the waistband structure of the briefs to open the front segment and crotch segment of the briefs and the liner away from the front segment of the waistband structure and the liner can be inspected and removed from the briefs, and another duplicate liner can be inserted into position in the briefs and the upper end portion of the front segment of the releasable panel reconnected to the inside surface of the front segment of the waistband structure, without removing the briefs from the person.

As explained in the Abstract, Schmitz is directed to articles that are "essentially designed as conventional disposable diapers, however, they are provided with an endless circular waistband." In this regard, "[t]he absorbent training pant (10) typically

is structured like a regular disposable diaper portion (17),” comprising a top sheet 12, a backsheet 11, and an absorbent core 14 and core patch 15 (page 6, lines 1-5). As shown in Figure 3, the front segment of the diaper is removably attached to the inner surface of the front portion of the waistband (page 7). However, the absorbent core is non-releasably secured to the crotch portion of the diaper, that is, it is not removable therefrom. In our opinion, one of ordinary skill in the art would have recognized that Schmitz discloses a conventional disposable diaper to which an elastic front waistband portion has been added to create, together with the rear top portion of the diaper, an endless circular waistband, the purpose being to provide some advantages over conventional side-opening disposable diaper constructions.

With regard to the structure recited in the appellants’ claim 11, Schmitz fails to disclose a garment comprising reusable briefs and a removable absorbent liner, in which the front panel of the briefs can be released from the waistband so the liner can be inspected and removed and replaced, if necessary, without removing the waistband of the briefs from the user. As the appellants have pointed out, the only way a soiled absorbent liner can be removed from the wearer in the Schmitz system is to replace the entire garment.

Recognizing the deficiencies of Schmitz, the examiner looks to Cooper, Reindl and Pigneul, each of which discloses a garment having a reusable outer portion and a replaceable absorbent pad. In all three of these secondary references, the front and

back segments of the reusable portion of the garment are fastened together at the sides, and thus none have an endless encircling waistband. The examiner takes the position that it would have been obvious to one of ordinary skill in the art to modify the Schmitz garment by replacing the non-removable absorbent pad with a removable one, "in view of the recognition that such would enable more universal usage by all different kinds of users," as expressed by Schmitz in lines 17-20 of page 5 (Paper No. 16, page 5). We note, however, that in the cited paragraph, Schmitz merely states that the term "absorbent article" in the description of the invention includes adult incontinence products, female hygiene pads, baby diapers and training pants, which does not provide reasoning in support of the examiner's proposed modification of Schmitz and does not alter the fact that Schmitz discloses only a one-piece disposable article.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to perceive any teaching, suggestion or incentive in any of the applied references which would have led one of ordinary skill in the art to modify the Schmitz garment in the manner proposed by the examiner. The objective of the Schmitz invention is to provide an improved disposable absorbent article (page 3), and we therefore see no reason why the artisan would be motivated to modify this single use article so that the absorbent pad can be replaced, for that would destroy the essence of the Schmitz



invention. It is our view that suggestion for making the proposed modification to Schmitz is found only in the hindsight afforded one who first viewed the appellants' disclosure which, of course, is not a proper basis for a rejection under Section 103. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The combined teachings of the four references therefore do not establish a prima facie case of obviousness with regard to the subject matter recited in independent claim 11, and the rejection of claim 11 as being unpatentable over Schmitz in view of Cooper, Reindl and Pigneul is not sustained. Independent claims 16 and 19 contain like limitations, and on the basis of the same reasoning the rejection of these claims as well as dependent claim 18 also is not sustained.

In a separate rejection, the examiner also determines that claims 1 and 4 are unpatentable over Schmitz in view of Cooper, Reindl and Pigneul. However, no reasoning regarding this rejection is set forth other than instructions to "see discussion of claims 11, 16 and 18-19 above" (Paper No. 16, page 6). In view of the fact that claim 1 contains the same limitations which were the subject of our attention with regard to the rejection of claim 11 et al. above, we shall not sustain the rejection of claims 1 and 4 for the same reasons as were set forth above with regard to claim 11.

Claims 2, 12 and 14, which depend from claims 1 and 11, are rejected on the basis of Schmitz in view of Cooper, Reindl and Pigneul, taken further with Gagnon, which is cited for teaching adding a seam to an absorbent material to provide stability.

Claim 3, which depends from claim 1, stands rejected as being unpatentable over the references applied against claim 1, taken further with Stevens and Enloe. Claim 3 adds protective wings bonded to the crotch portion of the disposable liner, and the additional references are cited for teaching such a feature. Be that as it may, neither Stevens nor Enloe alleviate the deficiency pointed out above in the basic combination of Schmitz, Cooper, Reindl and Pigneul, and therefore the rejection of claim 3 will not be sustained.

The rejection of claims 12, 16 and 18 under 35 U.S.C. § 112, second paragraph, is sustained.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

NEAL E. ABRAMS  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

)  
)  
)  
) BOARD OF PATENT  
) APPEALS AND  
) INTERFERENCES  
)  
)  
)  
)  
)  
)

NEA/lbg

Appeal No. 2001-2629  
Application No. 08/931,080

Page 12

GEORGE M. THOMAS  
THOMAS, KAYDEN, HORSTEMEYER & RISLEY  
100 GALLERIA PARKWAY, N.W., SUITE 1750  
ATLANTA, GA 30339-5948